No. 93-862

In The

Supreme Court of the United States

October Term, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,

Petitioner,

vs.

DONNELLEY INFORMATION PUBLISHING, INC. and THE REUBEN H. DONNELLEY CORPORATION,

Respondents.

On Petition For A *Writ of Certiorari*
To The United States Court Of Appeals
For The Eleventh Circuit

MOTION AND BRIEF *AMICUS CURIAE* OF SPRINT PUBLISHING & ADVERTISING, INC. IN SUPPORT OF PETITIONER

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MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF SPRINT PUBLISHING & ADVERTISING, INC.

COMES NOW, Sprint Publishing & Advertising, Inc. and respectfully petitions this Honorable Court for leave to file the annexed brief *amicus curiae* pursuant to Rule 37.4. Sprint Publishing & Advertising, Inc. (SPA) has requested consent from all parties for the filing of a brief *amicus curiae,* but has received only the consent of the Petitioner, a copy of which has been filed with this Court. In support of this motion, SPA states:

SPA is a Kansas Corporation.[1] SPA is engaged in the business of publishing classified telephone directories, commonly known as the "Yellow Pages". SPA currently publishes 278 separate classified telephone directories with a total circulation of approximately 12,000,000 copies each year. In excess of fifty of these directories are published independently of local telephone companies. The remainder of the SPA directories are published for telephone companies furnishing utility telephone services to specific operating territories. SPA distributes Yellow Pages directories in twenty states spread over a wide geographic area throughout the United States. SPA is thus in a unique position with respect to others in the industry who are typically either only an "independent" or a "utility" publisher, or who concentrate their activities in only a particular geographic area.

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[1] SPA is a wholly owned subsidiary of DirectoriesAmerica, Inc., a Kansas corporation, which is in turn a wholly owned subsidiary of Sprint Corporation, a Kansas corporation.

SPA has historically regarded its Yellow Pages directories as protected by the copyright laws and thus protected from appropriation by others. Substantial creative effort is expended in formulating, compiling and publishing the Yellow Pages, and it is the selection and arrangement of the content of the SPA classified directories that give them value to the user.

Because SPA publishes its directories for distribution in twenty states over dispersed areas, SPA regards the *en banc* opinion as particularly disturbing. Because of the tension created between the different interpretations of this Court's precedent by the Second and Eleventh Circuits, and the underlying implications not only for the Yellow Pages but for all other compilations of information, SPA and other publishers must follow the copyright laws differently according to geography. A Yellow Pages directory published in Florida will receive less protection than a corresponding directory published in, for example, New York.

Further, SPA must now speculate whether other jurisdictions in which it publishes or seeks to publish directories will follow the Second Circuit or the Eleventh Circuit in determining copyright protection for Yellow Pages compilations. The problems created by this split include evaluating whether to protect existing copyrights and to what extent it may use the compilations of others in creating new directories. SPA has previously sought to enforce the copyright in its Yellow Pages directory, only

to be confronted with the decision below which essentially eliminates any protection for the underlying compilation in its Yellow Pages.

The interests of SPA thus transcend those of the parties in that it sees the controversy presented from the perspective of a publisher of directories akin to both Petitioner and Respondent. While Petitioner may advance the views typically held by the utility publisher and Respondent will espouse the views of the independent publisher, it is unlikely that either Petitioner or Respondent will present arguments for balancing the concerns for originality, with proper access to information, best represented by SPA which must do both with consistency. If SPA is not permitted to file a brief *amicus curiae* this perspective will be unaddressed.

Respectfully submitted,

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BRIEF *AMICUS CURIAE* OF SPRINT PUBLISHING & ADVERTISING, INC. IN SUPPORT OF PETITIONER

Sprint Publishing & Advertising, Inc. (SPA) respectfully submits this brief *amicus curiae* in support of BellSouth Advertising & Publishing Corporation, the Petitioner for *certiorari*, whose consent has been provided to the Clerk of the Court under separate cover. Respondents have declined to give consent and therefore a Motion for Leave to File Brief Amicus Curiae is provided herewith.

INTERESTS OF *AMICUS CURIAE*

Sprint Publishing & Advertising, Inc. is a Kansas corporation engaged in the business of publishing classified telephone directories, known throughout the United States as the "Yellow Pages". SPA publishes 278 separate editions of its Yellow Pages directory with a total circulation of approximately 12,000,000 copies published and distributed each year. It publishes these Yellow Page directories in 20 states dispersed over a wide geographic area throughout the United States. SPA publishes directories in conjunction with the telephone utilities in many geographic areas, and also publishes over fifty independent Yellow Page directories.

SPA devotes considerable creative effort in producing directories which it believes are significant, useful and original compilations of information. In order to make each directory useful to both advertisers and consumers, considerable creative effort is devoted to the selection, arrangement and coordination of individual listings under appropriate headings for each directory.

The impact of the *en banc* decision below is particularly disturbing to SPA. By permitting the copying of Yellow Pages directories, other publishers no longer need to devote the substantial creative energies required to produce an independent Yellow Pages compilation. Instead, it is far easier to merely appropriate the arrangement, selection and coordination of an existing compilation of information. In fact, it is only the selection, arrangement and coordination which is appropriated, as

the raw listing data is already available from the White Pages or other alternative sources.

Given the contrary interpretation of this Court's precedents by other circuits, SPA must now operate under great uncertainty as to the protectability of its compilations, depending on the area of publication. If the present decision is permitted to stand, the protectability of Yellow Pages compilations will be determined according to their geographic origin, and SPA and others will face tremendous uncertainty in how to proceed with creating new directories and protecting existing directories.

REASONS FOR GRANTING THE WRIT

Unless resolved by a grant of *certiorari*, the decision below, in the words of the dissenting opinion, "transforms the classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decisionmaking, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product." SPA is among those publishers which has already encountered this type of competition, which often results in inferior works necessarily based on the compilation set forth in Yellow Pages directories previously published and distributed by SPA.

The decision below places classified directory publishers in the untenable position of deciding whether to follow the Second Circuit or the diametrically opposed decision of the Eleventh Circuit regarding classified directories. Each of these two Circuits has read this

Court's ruling on the constitutionally-imposed threshold standard of "originality" regarding Yellow Page compilations differently. Moreover, the decisions in other Circuits which have applied this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 111 S.Ct. 1282 (1991) to the protectability of compilations have diverged substantially from the views expressed in the *en banc* decision below. Thus, in light of the exceptional importance of this decision to not only directory publishers but to others seeking copyright protection for compilations, and given the constitutional foundation of the issue, it is critical that this Honorable Court grant *certiorari*.

I. THE DECISION BELOW CREATES AN UNTENABLE TENSION IN THE CIRCUITS FOR YELLOW PAGES PUBLISHERS

A direct and unreconciled conflict exists between the decision below and the decision in *Key Publications v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2nd Cir. 1991) over the interpretation of this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991). Resolution of the question presented by the Petitioner will do more than resolve an academic question regarding the standard of originality necessary for protection under the Copyright Act by aiding SPA and others who must publish directories in multiple areas throughout the United States.

While some Yellow Pages publishers may distribute their directories in a relatively confined geographic territory, SPA and many others must now endeavor to apply

the Copyright Act, 17 U.S.C. § 101 et seq. on a Circuit-by-Circuit basis. The entire process of publishing a Yellow Pages directory in a new territory must now include a guess as to whether the decision below or that of the Second Circuit in *Key Publications v. Chinatown Today Publishing Enterprises*, 948 F.2d 509 (2nd Cir. 1991) will be applied.

Key Publications considered the question of copyrightability of a classified telephone directory using the *Feist* decision as a template. In applying the language of 17 U.S.C. § 101, it used three tests to evaluate the originality of the classified directory: "(1) the collection and assembly of preexisting data; (2) the selection, coordination or arrangement of that data; and (3) a resulting work that is original, by virtue of the selection, coordination or arrangement of the data contained in the work." *Key Publications*, 945 F.2d at 512. It found that the classified telephone directory under consideration satisfied each of those tests.

The underlying decision of the District Court also found that the Yellow Pages directory was protectable as a compilation. Following earlier precedent in the Circuit regarding copyrightability of Yellow Pages directories, the District Court also found that "because BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material, the Court concludes that BAPCO's compilation is an original work of authorship which is subject to a valid copyright." *Bellsouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc.*, 719 F.Supp. 1551, 1557 (S.D. Fla. 1988), *aff'd*, 933 F.2d 952 (11th Cir. 1991), *vacated and*

reh'g en banc granted, 977 F.2d 1435 (11th Cir. 1992), *rev'd*, 999 F.2d 1436 (11th Cir. 1993) (en banc).

But the *en banc* holding herein concluded that the elements of selection, coordination and arrangement identified by the District Court and purportedly copied by Donnelly, as a matter of law, do not display the originality required to merit copyright protection (999 F.2d at 1444). SPA is now left to a Circuit-by-Circuit application of the copyright to its directories. Is the stricter application of the test for originality as espoused by the decision below to be followed in other Circuits? Or perhaps the view articulated by Judge (now Justice) Bader Ginsburg in *Atari Games Corp. v. Oman*, 979 F.2d 242, 247 (D.C. Cir. 1992) that "the vast majority of works make the [copyright] grade quite easily", and that nothing "beyond the 'minimal creative spark required by the Copyright Act and the Constitution'" will be required to protect a compilation.

SPA is faced with great uncertainty in undertaking the publication of a new classified directory in determining to what extent existing directories may be used as a resource for a new compilation. Similarly, may SPA protect its directories from copying by competitors who merely use a data processor to glean not only the factual data already available from the White Pages listings but also SPA's own selection, arrangement and coordination? And if so, in what jurisdictions do the different applications of the constitutional test of originality apply?

SPA believes that only resolution by this Court will resolve the conflict created by the decision below.

II. THE DECISION BELOW CONFLICTS WITH THIS COURT'S PRECEDENT IN *FEIST*

The decision of this Court in *Feist* was confined to the consideration of the copyrightability of telephone listings arranged in alphabetical order and expressly did not extend to the Yellow Pages portion of telephone directories. The *en banc* decision below improperly extended the holding in *Feist* to virtually eliminate copyright protection for classified telephone directories; that is, those Yellow Page directories which this Honorable Court expressly exempted from consideration.

Throughout her opinion in *Feist*, Justice O'Connor repeatedly and carefully restricted her analysis to the white pages portion of the Rural directory, which presents an alphabetical arrangement of listings (i.e., the name, address and telephone number). "In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity." In so holding, this Court provided a bright line test to SPA and others which could be readily and easily applied. On the other hand, Justice O'Connor also pointed out that the white pages listings were not original to Rural "and therefore were not protected by the copyright in Rural's combined white and yellow pages directory." 111 S.Ct. at 1297.

Throughout the *Feist* opinion, Justice O'Connor emphasized that the threshold consideration for determining copyrightability in compilations is the statutory and constitutional requirement of originality. In the case

of compilations, "even a directory that contains absolutely no protectable written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection and arrangement." 111 S.Ct. at 1289. "These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws." *Id.*, 111 S.Ct. at 1289.

Notwithstanding a finding by the District Court setting forth in detail the elements which led to its finding that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material", the *en banc* decision below found that each of BAPCO's activities regarding selection, coordination and arrangement were unoriginal and "entirely typical" of the type of directory.

It is thus clear to SPA that the decision below interprets the requirement of a "minimal creative spark" quite differently from the holding in *Feist*. The unwarranted extension of *Feist* to Yellow Pages directories inevitably threatens the scope of protection available to all compilations. While the mere facts contained in those compilations have never been protectable, if the decision below is permitted to stand, few compilations (i.e., a work embodying an original selection, arrangement or coordination of those facts) will enjoy any protection from direct copying, as was admittedly the case in the controversy below.

Only by directly addressing the question presented by the Petitioner may this Court stem the unwarranted and unjustified extension of its holding in *Feist*.

III. THE DECISION BELOW CONFLICTS WITH THE DECISIONS IN OTHER CIRCUITS REGARDING THE CONSTITUTIONAL STANDARD OF ORIGINALITY

Since this Court's decision in *Feist*, the question of protectability of compilations has been addressed by at least four other Circuits. With the sole exception of the *en banc* decision below, the Circuits have found sufficient originality in the compilations presented to warrant copyright protection.

First, this Court should recognize that the panel decision below was cited favorably in the decision by Judge (now Justice) Bader Ginsburg in *Atari Games*, 979 F.2d at 245, and also by the Second Circuit in *Key Publications*, 945 F.2d at 515. Thus, the decision *en banc* reversing the panel decision and adopting a much stricter view of originality inherently conflicts with those decisions.

Moreover, the application of *Feist* by those other Circuits contrasts markedly with the *en banc* decision below. In *Atari Games*, the selection and arrangement of the graphic elements in individual screens and then selecting and arranging the sequence of those screens was not "mechanical," "garden-variety," "typical," "obvious," or so commonplace as to be "practically inevitable". In *Key Publications*, both the District Court and the decision of the panel on appeal agreed that the selection, coordination and arrangement of listings entailed the de minimis

thought needed to withstand the originality requirement. But the *en banc* decision below, notwithstanding a plethora of acts of selection, arrangement and coordination recited first by the District Court, then by the panel, and finally by the dissent, determined those acts to be unoriginal and practically inevitable, and thus wanting in originality.

Thus, the *en banc* decision below stands out as misapplying the tests for originality resulting in a far stricter test for copyrightability than warranted by *Feist*. Moreover, the holding stands in stark contrast to the recognition by other circuits that "the requisite level of creativity is extremely low; even a slight amount will suffice." *Los Angeles News Service v. Tullo*, 973 F.2d 791, 794-5 (9th Cir. 1992) (videotape); and also *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992) (maps), both quoting *Feist*, 111 S.Ct. at 1287 in finding sufficient originality to warrant copyright protection.

There is a distinct danger that the decision below will not only strip away the copyright protection for compilations in the Eleventh Circuit, but will be expanded to other Circuits which have not yet considered the application of *Feist*. Moreover, it is apparent that the decision below evinces a direct conflict with those Circuits which have already considered the application of *Feist* to copyrights. A full review of the decision below is necessary to enable SPA and others to conduct their business of creating compilations in a consistent manner throughout the United States.

CONCLUSION

For the foregoing reasons, a *writ of certiorari* should issue to review the *en banc* decision of the Eleventh Circuit Court of Appeals. The inevitable chaos created by conflicting interpretations of this Court's decision in *Feist* will be averted only by this Court's restoration of the proper statutory and constitutional determination of originality in compilations.

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